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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,117	08/02/2001	Daniel J. Pisano JR.	2106.002USU	7072

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EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,117

Applicant(s)

PISANO ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1 and 3-20 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 2/16/06 is sufficient to overcome the prior rejection. A new reference has been added to the 35 USC 103 rejection.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda (5,890,137) in view of Deaton (5,687,322).

Claim 1, 11, 20: Koreeda discloses a method, system of providing a consumer with a shopping incentive comprising:

- (a) determining a plurality of fixed price options to purchase goods/services offered by a plurality of stores (Fig. 2; Fig. 1; Fig. 5; Fig. 6);
- (b) presenting a web page to a terminal used by said consumer wherein the web page contains one or more of said plurality of options (Fig. 2; Fig. 1; Fig. 5; Fig. 6);
- (c) establishing an identity of said consumer (Fig. 2; Fig. 7); and

Art Unit: 3622

(d) presenting said selected option and said consumer identity to said selected store in response to said consumer selecting, via said terminal, one of said plurality of options and one of said plurality of stores (col 2, lines 50-60; col 5, lines 55-60).

Koreeda further discloses an application computer that presents web pages to a consumer via the Internet (Fig. 1; Fig. 12; col 1, lines 5-11; col 5, lines 37-50).

Koreeda does not explicitly disclose a server.

However, Koreeda discloses service centers connected to the Internet, computers connected to the Internet that serve webpages (Fig. 1; Fig. 12; col 1, lines 5-11; col 5, lines 37-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Koreeda's computer connected to the Internet that serves webpages can be a server. One would have been motivated to do this in order to utilize a hardware terminology that is standard for computers connected to a network.

Koreeda further discloses updates to the fixed price of one of said plurality of options if requested by one of said plurality of stores that offers said one option whose price is being changed (Fig. 1; Fig. 5; col 2, lines 40-44).

Koreeda does not explicitly disclose that, as said shopping incentive, adjusting the fixed price of one of said plurality of options if requested by one of said plurality of stores that offers said one option whose price is being adjusted.

However, Deaton discloses, as said shopping incentive, adjusting the fixed price of one of said plurality of options if requested by one of said plurality of stores that offers said one option whose price is being adjusted (col 74, line 16-col 75, line 8).

Art Unit: 3622

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's shopper sensitive shopping incentives to Koreeda's shopping mall for allowing a shopper to make purchases. One would have been motivated to do this in order to better incite purchases.

Claim 3, 14: Koreeda and Deaton disclose the method of claim 1.

Koreeda further discloses that the store controls product data such as price (Fig. 1; Fig. 5; col 2, lines 40-44).

Koreeda does not explicitly disclose that step (a) determines the fixed prices of said plurality of options from inventory data of said plurality of stores and other data deemed relevant by said plurality of stores.

However, Deaton discloses that step (a) determines the fixed prices of said plurality of options from inventory data of said plurality of stores and other data deemed relevant by said plurality of stores (col 103, lines 5-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's price adjusting based upon inventory to Koreeda's store controlled pricing. One would have been motivated to do this in order to provide prices that are relevant to a store's current business situation.

Claims 4, 5, 10, 13, 15, 16: Koreeda and Deaton disclose the above.

Koreeda further discloses tracking customer personal data (Fig. 1; Fig. 7; Fig. 8; Fig. 9a).

Koreeda further discloses recording where the user made a purchase (Fig. 13; Fig. 14; Fig. 15).

Koreeda does not explicitly disclose tracking customer purchases and performing appropriate targeting.

However, Deaton discloses tracking customer purchases and performing appropriate targeting, including price adjusting (col 74, line 16-col 75, line 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's targeting to Koreeda's known user purchase information. One would have been motivated to do this in order to present product information to the user that will more likely be of interest to the user.

Claim 6, 17: Koreeda and Deaton disclose the above.

Koreeda does not explicitly disclose that said other data includes marketing goals of said plurality of stores.

However, Deaton further discloses that said other data includes marketing goals of said plurality of stores (col 105, lines 14-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's marketing goals to Koreeda's product selling system. One would have been motivated to do this in order to more effectively sell products.

Claim 7, 12: Koreeda and Deaton disclose the above. Koreeda further discloses determining a reimbursement to said selected store in response to receipt from said selected store of information identifying an exercise of said selected option by said consumer including the option price and a then prevailing price (Fig. 13).

Claim 8, 18: Koreeda and Deaton disclose the above. Koreeda further discloses that at least one of said plurality of options is offered by a supplier of said goods/services (Fig. 11).

Claim 9, 19: Koreeda and Deaton disclose the above.

Koreeda does not explicitly disclose that said supplier is a manufacturer of one of said goods/services.

However, Deaton further discloses that a seller can be a manufacturer (col 74, lines 20-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's manufacturer to Koreeda's supplier of goods. One would have been motivated to do this in order to present flexible options as to who the seller is.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 3-20 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that Applicant changed the independent claims with the addition of "as said shopping incentive" before the features added to the independent claims.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being

Art Unit: 3622

referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran  
Primary Examiner  
6/7/2006